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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,694	01/18/2002	Michael E. Lester	33552	1533
116	7590	05/19/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			KIM, PAUL D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

5A

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/051,694	LESTER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Paul D Kim	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33 and 37-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is a response to the restriction requirement filed on 3/29/2005.

#### ***Response to the Restriction Requirement***

1. Applicant's election without traverse of Group II, claims 33 and 37-41 in the reply filed on 3/29/2005 is acknowledged.
2. Claims 32 and 34-36 are canceled in the reply filed on 3/29/2005.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 33 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (JP-09022625 A) in view of Baker (US PAT. 4,437,829) and Akagi (US PAT. 5,830,592).

Ueda teaches a jacket assembly for a cable comprising: an elongated jacket (105) comprising a first open end and a second open end as shown in Fig. 1 (a); a leader (conductor) extending (101) within the jacket from the first open end and the second open end as shown in Fig. 1 (b); a first end of the leader for attachment to a cable (103); and a second end of the leader for pulling the leader out of the elongated

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jacket while the first end of the leader pulls the cable into the elongated jacket as shown in Fig. 1 (c) (see also abstract).

However, Ueda does not disclose whether the leader (conductor) is a material that narrows as the leader is elongated by a pulling force. Baker teaches an electrical device such as detector having a fuse element made of soft conductive material such as lead in order to minimize stretching the fuse element (see also col. 4, lines 53-55). Also, Akagi teaches a fuel cell including a fuel gas passage filled with a soft conductive material, which can be a felt material (as per claim 37) such as Ni in order to have a good heat resistance (see also col. 8, lines 17-20). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify a leader of Ueda by a soft conductive material as taught by Baker in order to minimize stretching and Akagi in order to have a good heat resistance.

In addition, the elongated jacket of Ueda is an elastic jacket. Therefore, it would have been an obvious matter of designer's choice to modify the elastic jacket of Ueda by the vinyl material or PVC to obtain the invention as specified in claims 37 and 40.

As per claim 38 dimensions of the leader as a continuous strip of Ueda is approximately the same as dimensions of the cable as shown in Fig. 1 (b) and (c).

As per claim 39 the jacket of Ueda is extruded around the leader as shown in Fig. 1 (b) and (c).

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda in view of Baker and Akagi, further in view of Maroschak (US PAT. 3,870,774).

Ueda, modified by Baker and Akagi, teaches all of the limitations as set forth above except forming the jacket assembly to cut off a desired length. Maroschak teaches a corrugated plastic tube, which is conventionally formed in continuous lengths, it is generally shipped to the consumer either in rolls of a predetermined number of linear feet or in bundles of cut lengths of tubes containing a predetermined linear footage as shown in Fig. 2 (see also col. 1, lines 7-50). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify a jacket assembly of Ueda, modified by Baker and Akagi, by the jacket to cut off a desired length as taught by Maroschak in order to improve to cut off the tube at the desired end or length.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 33 and 37-41 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 11/19/2004 have been fully considered but they are not persuasive. Applicant argues that the prior art of record fails to disclose the claimed invention such as a felt leader. Even though Ueda does not disclose the felt leader or the material that narrows as the leader is elongated by a pulling force, the conductor leader of Ueda can be made by a soft conductive material as described by Baker or the felt material as described by Akagi, which can be also elongated by a pulling force. Therefore, it would be obvious to modify the conductor leader of Ueda by a soft

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conductive material as taught by Baker and Akagi in order to stretch or elongate by a pulling force.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Friday between 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim  
Examiner  
Art Unit 3729